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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,057	06/25/2007	Kenji Kawai	358362011500	8885
25227	7590	01/04/2011	EXAMINER	
MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD SUITE 400 MCLEAN, VA 22102				JACOBSON, MICHELE LYNN
ART UNIT		PAPER NUMBER		
1782				
			NOTIFICATION DATE	DELIVERY MODE
			01/04/2011	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/594,057	KAWAI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	MICHELE JACOBSON	1782	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 22 September 2010.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,2,4-8,10,13,14 and 16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,2,4-8,10,13,14 and 16 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/19/10, 8/11/10</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Examiner Notes***

1. Any objections and/or rejections made in the previous action, and not repeated below, are hereby withdrawn.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1, 7 and 8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2-5 of copending Application No. 11/912978. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 2-5 of copending Application No. 11/912978 teach the limitations of instantly pending claims 1, 7 and 8.

4. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

Art Unit: 1782

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 2, 4-8, 13, 14 and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

7. Claim 1 has been amended to include the limitation "the substrate layer not being configured to be heat sealed". There is no support for this limitation in applicant's specification as filed. Applicant's disclosure fails to disclose that the substrate layer is not "configured to be heat sealed" or that it is "configured to be heat sealed" which could also provide support for the newly added negative limitation. Claims 2, 4-8, 13, 14 and 16 are rejected for being dependent from claim 1 and as such necessarily incorporating the new matter therein.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1, 2, 4-8, 13, 14 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1782

10. Claim 1 has been amended to include the limitation "the substrate layer not being configured to be heat sealed". It is unclear how the substrate layer would be required to be "configured" in order to "not be configured to be heat sealed". Does this limitation have anything to do with the composition of the substrate layer? The thickness? The physical configuration? Since one of ordinary skill in the art would be unable to determine what "configurations" of the heat seal layer would be excluded by this limitation, one of ordinary skill in the art would not be reasonably apprised of the full scope and breadth of the invention claimed. Being as this limitation does not appear to provide any functional or structural limitations to the invention claimed, this limitation will be given no patentable weight for the purpose of examination. Claims 2, 4-8, 13, 14 and 16 are rejected for being dependent from indefinite claim 1.

11.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Art Unit: 1782

13. Claims 1, 2, 4, 5, 7, 8, 10, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohyama et al. U.S. Patent No. 4,726,999 (hereafter referred to as Kohyama).

14. Kohyama teaches a laminated structure having excellent heat sealability at low temperatures and heat seal strength, a broad range of heat sealable temperatures, and also superior scratch resistance and antiblocking property. The laminated structure is disclosed to be very useful in the form of a laminate fiber or sheet, a laminated package or container, etc. in the field of packaging various products or articles including foodstuffs, apparels, daily goods and sundries (Col. 1, lines 21-27) The laminated structure disclosed comprises a substrate layer of a crystalline propylene resin and, positioned in direct contact with at least one surface thereof, a heat-sealable layer of a crystalline random propylene copolymer composition. (Col. 3, lines 60-64)

15. The laminated structure disclosed is characterized in that the crystalline random propylene copolymer composition is a mixture of (I) and (II) indicated below in a (I)/(II) weight ratio of from 5/95 to 90/10.

- I. A crystalline random propylene copolymer of a major amount of propylene with a minor amount of another alpha-olefin, and
- II. a random copolymer consisting essentially of more than 60 to 99 mole % of 1-butene and less than 40 to 1 mole % of propylene.

12. Advantageously, the copolymer (II) has a Young's modulus (J), measured by the method of JIS K-7113, of 1000 to 6000 kg/cm<sup>2</sup>, preferably 1100 to 5000 kg/cm<sup>2</sup>. (Col. 8, lines 40-42)

Art Unit: 1782

13. The crystalline propylene resin constituting the substrate layer of the laminated structure may comprise crystalline random copolymers of a major proportion of propylene with up to about 10 mol%  $\alpha$ -olefins other than propylene, for example C<sub>2</sub>-C<sub>10</sub>  $\alpha$ -olefins. (Col. 5, lines 22-28) The crystalline propylene resin comprising the substrate layer is disclosed to have a crystallinity as measured by X-ray diffractometry of 55 to 70%. (Col. 5, lines 38-43)

14. The substrate layer of the crystalline propylene resin constituting the laminated structure of this invention may be non-stretched or in a monoaxially or biaxially stretched state. The heat-sealable layer of the crystalline random propylene copolymer composition may likewise be non-stretched or in a monoaxially or biaxially stretched state. Hence, the substrate layers in the above states and the heat-sealable layers in the above states may be used in any desired combinations. (Col. 4, lines 31-39)

15. In the laminated structure of this invention, the thickness of the substrate layer can be properly selected and is, for example, from 5 to 200  $\mu\text{m}$ . The thickness of the heat-sealable layer can also be properly selected, and is, for example, about 0.1 to about 50  $\mu\text{m}$ , preferably about 0.5 to about 30  $\mu\text{m}$ . These thicknesses may be varied properly depending upon the shape, type, etc. of the laminated structure. For example, in the case of a laminated film or sheet, the substrate layer may have a thickness of about 5 to about 200  $\mu\text{m}$ , preferably about 10 to about 70  $\mu\text{m}$ , and the heat-sealable layer may have a thickness of about 0.1 to about 50  $\mu\text{m}$ , preferably about 0.5 to about 30  $\mu\text{m}$ . (Col. 4, lines 40-52)

Art Unit: 1782

16. The heat seal strength when the film is sealed to itself at 130° C is disclosed to be 16.7 N/15 mm in Table 3, example 1.

17. Kohyama additionally discloses crystalline propylene resin films or sheets have found extensive use in the field of packaging, particularly packaging of foodstuffs, because of their superiority in mechanical properties such as tensile strength, rigidity, surface hardness and impact strength, optical properties such as gloss and transparency, and food hygiene such as the freedom from toxicity and odor. They, however, have the defect that temperatures at which a single layer of such a crystalline propylene resin film can be heat-sealed are high and a proper range of these heat-sealing temperatures is narrow. (Col. 1, lines 55-65)

18. Kohyama is silent regarding disposing an additional heat seal layer on the substrate layer to sandwich the substrate layer between heat seal layers.

19. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have disposed an additional heat seal layer on the crystalline propylene substrate layer opposite the heat seal layer disclosed by Kohyama in order to provide an additional heat sealing surface to the film so that lap seals could be formed with the film. This obvious duplication of the heat seal layer disclosed by Kohyama would have solved the defect of crystalline propylene films that temperatures at which a single layer of such a crystalline propylene resin film can be heat-sealed are high and a proper range of these heat-sealing temperatures is narrow disclosed by Kohyama by providing a suitable heat sealing surface.

Art Unit: 1782

20. Regarding claims 1, 7 and 8: The limitation that “the substrate layer not being configured to be heat sealed” recited in claim 1 is not interpreted by the examiner to have any patentable weight as explained above. The heat seal layer disclosed by Kohyama reads on the heat seal layer claimed by applicant and has a heat sealing strength which falls within the range claimed by applicant. The heat seal layer of Kohyama also reads on the substrate layer claimed by applicant since component (I) of the heat seal layer is disclosed to be a crystalline polypropylene resin.

21. The substrate layer of Kohyama reads on the intermediate layer claimed by applicant and is recited to have a crystallinity as high as 70%. Although Kohyama is silent regarding the cold xylene-soluble fraction of the crystalline α-olefin copolymer substrate layer, since the materials disclosed by Kohyama are the same as disclosed by applicant, and the substrate layer of Kohyama is specifically disclosed to be highly crystalline it naturally follows that the α-olefin copolymer substrate layer of Kohyama would have a cold xylene-soluble fraction in a proportion of not more than 3% by weight. As such, the obvious modification of Kohyama to provide an additional heat sealable surface to the film disclosed would have produced the same invention as claimed in claim 1, 7 and 8.

22. Regarding claim 2: The film thicknesses disclosed by Kohyama overlap or encompass the range thicknesses for the layers of the film claimed in claim 2. In the case where the claimed ranges “overlap or lie inside ranges disclosed by the prior art” a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990)

Art Unit: 1782

23. Regarding claims 4, 5, 10, 14 and 16: It would have been obvious to one having ordinary skill in the art at the time the invention was made to have mixed in some of the crystalline polypropylene resin comprising the heat seal layer with the resin comprising the substrate layer since the examiner takes official notice that it was universally known in the polymer arts at the time the invention was made that providing a mixture of the resins comprising two polymer layers to be bonded between the layers increases the adhesion of the layers. This obvious utilization of a technique well known in the art to improve the adhesion between two polymer layers would have produced the invention as claimed in claims 5 and 10. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have optimized the amount of heat seal resin added to the substrate layer in order to maintain the strength of the crystalline polypropylene copolymer which still allowing for optimal adhesion. The obvious optimization of a result effective variable would have produced the same invention as claimed in claims 4, 14 and 16.

24. It is noted by the examiner that the official notice taken by the examiner in the office action dated 6/23/10 that it was universally known in the polymer arts at the time the invention was made that providing a mixture of the resins comprising two polymer layers to be bonded between the layers increases the adhesion of the layers is taken to be admitted prior art because applicant failed to traverse the examiner's assertion of official notice. (See MPEP 2144.03C)

Art Unit: 1782

25. Claims 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohyama et al. U.S. Patent No. 4,726,999 (hereafter referred to as Kohyama) as applied to claims 1 and 4 above in further view of Food Packaging Technology, ed. Coles et al., CRC Publishing, 2003, pg. 318 (hereafter referred to as Coles).

26. Kohyama teaches what has been recited above but is silent regarding imparting antifog properties to the laminate disclosed.

27. Coles teaches Condensation (fogging) of water vapour on the inner surface of food packs can occur when the temperature of the pack environment is reduced, resulting in a temperature differential between the pack contents and the packaging material. Fogging of the inner surface of lidding film is a result of light scattering by the small droplets of condensed moisture that leads to poor product visibility and an aesthetically unpleasing appearance of the pack. This can be overcome by applying antifogging agents to the plastic heat sealing layer, either as an internal additive or as an external coating. These chemicals decrease the surface energy of the packaging film which enables moisture to spread as a thin film across the under surface of the pack rather than collecting as visible droplets. Antifogging agents include fatty acid esters. Most lidding materials are available with antifog properties, and commonly treated plastics include LDPE, LLDPE, EVA and PET. (Pg. 318)

28. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have applied an antifogging agent such as disclosed by Coles to the heat seal layer of Kohyama in order to prevent fogging and its deleterious effects. It would have been obvious to one having ordinary skill in the art at the time the invention

was made to have optimized the amount of such an additive in order to obtain the most beneficial reduction in the amount of fogging by sufficiently decreasing the surface energy of the film. Such an optimization of the amount of additive in the modified invention of Kohyama would have produced a film with the same characteristics as claimed in claims 6 and 13.

***Response to Arguments***

16. Applicant's arguments filed 9/22/10 have been fully considered but they are not persuasive.

17. Applicant's arguments on page 4 of the remarks regarding the previous rejection under 112 1<sup>st</sup> paragraph are moot in light of applicant's amendment to claim 1 to remove "weight".

18. Applicant asserts on page 5 of the remarks that the heat seal layer of Kohyama would not satisfy "some" of the requirements for a substrate layer listed in applicant's specification. This argument is not germane since applicant fails to enumerate which "requirements" are not met and furthermore, none of these unidentified requirements are present in any of the claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

19. Applicant asserts on page 5 of the remarks that "person of ordinary skill in the art would have thought that Kohyama's heat seal layer does not correspond to the claimed substrate layer". Applicant has failed to provide any evidence to support this assertion of what one of ordinary skill in the art would have "thought". Furthermore, this argument fails to identify any material differences between the heat seal material disclosed by Kohyama and the substrate layer claimed. Therefore, this argument is not germane and is not found persuasive.

20. As explained above, applicant's assertion on page 6 that the amendment to claim 1 to recite that the substrate layer is "not configured to be heat sealable" fails to provide any structural or compositional limitations to claim 1 and is additionally unsupported by applicant's disclosure as filed. Therefore, applicant's assertions on page 6 are not found persuasive.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHELE JACOBSON whose telephone number is (571)272-8905. The examiner can normally be reached on Monday-Thursday 8:30 AM-7 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571)272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michele L. Jacobson/  
Examiner, Art Unit 1782

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Examiner  
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